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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,822	01/23/2002	Volkmar Schwitzky	103797-238-NP	9521

7590

04/16/2003

Alison Kessler
Goodwin Procter LLP
Counsellors at Law
Seven Becker Farm Road
Roseland, NJ 07068

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,822

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 3-11-03
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4-6 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1762

Response to Amendment

Specification

1. The amendments in response to the objections to the specification, title, and abstract of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lacquering the whole surface of the security sheet in a second step, does not reasonably provide enablement for applying ANY coating to entire sheet as a second step. e.g. inks, CVD coatings, etc. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these claims. Applicants are directed to [0010] and [0011] which discloses only lacquering the whole sheet. This will be the

Art Unit: 1762

interpretation of the "coating" step of claim 1 by the Examiner for sake of examination.

4. The amendments in response to the 35 USC 112/ second paragraph rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 102

5. The claim rejections under this heading of the previous Office Action are withdrawn in view of amendment

Claim Rejections - 35 USC § 103

6. The claim rejections under this heading of the previous Office Action are withdrawn in view of amendment, the new rejections being necessitated by applicants' amendments.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzberg et al in view of Shenton.

Weitzberg et al teaches to apply printed indicia, photographs, and watermarks (= security feature per claims 4-5) to a base sheet material (paper,

Art Unit: 1762

transparent plastic, etc) and providing a protective transparent security coating (which increases durability relative the uncoated surface) of a lacquer or resin (per claim 6). The transparent/ clear lacquer would also inherently emphasize/optically accentuate underlying text and photographic features. See column 2, 30-36; column 3, 9-16; column 4, 4-43. Weitzberg et al additionally teaches on column 3, 37-56 to provide at least one additional characteristic print pattern on the photographic layer side to be subsequently over coated by the lacquer layer, such as by using "additional prints in colours different from that of the text of particulars, preferably by using combinations, of different colours...". Thus the text is suggesting the use of other colorations for use as security markings in concert with the photographic and text features applied. Use of a distinguishing feature on the photographic layer side which is partially coated and emphasized with lacquer prior to coating the protective transparent security coating is not cited.

Shenton teaches to locally apply a tinting lacquer over security paper printed with metallic inks and printed security indicia (= "security feature") to provide colored metallic effects. Since both the reference and claim 1 locally apply lacquer over a specific security feature, it would have been expected both would have produced the effect of increasing transparency. Column 2,

Art Unit: 1762

40-62. Such an application would meet the criteria of Weitzberg et al set forth on column 3 for an additional characteristic security pattern, and it therefore would have been an obvious variation to incorporate the colored metallic security pattern of Shenton into the method of Weitzberg et al to provide the additional distinguishing security features. The Examiner points out that both references deal with the identical problem, namely to provide distinguishing security features by printing on documents to make them tamper-proof. The Examiner also points out that applying a protective clear or colored overcoat to a printed article is well-known and conventional in the art, so that a final protective lacquer coating over the entire card after all security features are applied would have been an obvious step within the purview of one skilled in the art. Thus the incorporation of the security feature comprising metallic ink locally over coated with a tinting lacquer of Shenton in the process of Weitzberg et al would have been obvious to one of ordinary skill as a means of further providing colored distinguishing security features, which would further impede forgery or unauthorized reproduction and therefore provide the motivation for incorporating the feature of Shenton into the process of Weitzberg et al.

RESPONSE TO REMARKS

Art Unit: 1762

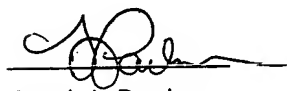
The remarks of Applicants have been carefully considered. The remarks are directed towards the amended claims as they now exist in the application relative to the previous prior art rejections. Response to these remarks is moot in view of the new rejections above which were necessitated by amendment. The new rejections take into account the arguments set forth in applicants' remarks.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1762

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

April 15, 2003

fr10-055822

**FRED J. PARKER
PRIMARY EXAMINER**